

REMARKS

A. Background

Claims 32-43 were pending in the application at the time of the Office Action. The Office Action objected to claims 38-41 based on informalities. Claim 33 was rejected as being indefinite. Claims 32, 34, and 36-43 were rejected as being anticipated by and/or obvious over cited art. Claims 32, 33, and 37 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting. Claim 35 was objected to as being dependent upon a rejected base claim. By this response applicant has cancelled claim 34; amended claims 32, 33, 35, and 37-41; and added new claims 44-50. As such, claims 32, 33, and 35-50 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Amendments

Applicant has herein amended the specification to correct various typographical and grammatical errors. Applicant has amended claims 32, 33, 35, and 37-41, and added new claims 44-50 to further clarify, more clearly define, and/or broaden the claimed inventions to expedite receiving a notice of allowance. The amendments to the claims are supported in the application at least by Figures 5-7 and 9 and the corresponding discussion in the specification. Applicant notes that new claims 47 and 50 are respectively prior claims 33 and 35 rewritten in independent form to include the limitations of claim 32 from which claims 33 and 35 previously depended. In view of the foregoing, Applicant submits that the amendments to the claims and the new claims do not introduce new matter and entry thereof is respectfully requested.

C. Rejection on the Merits

1. Objections to the Claims

Page 2 of the Office Action objects to claims 38-41 based on an alleged informality. In view of amendments made herein to claims 38-41, Applicant submits that the objections have been overcome and should be withdrawn.

2. Indefiniteness Rejection

Page 2 of the Office Action rejects claim 33 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that one of the elements of claim 33 lacks antecedent basis. In view of amendments made herein to claim 33, Applicant submits that the rejection has been overcome and should be withdrawn.

Furthermore, as noted above, Applicant has herein rewritten prior claim 33 in independent form as new claim 47, incorporating the limitations of claim 32, from which claim 33 previously depended and also incorporating the amendment made to current claim 33 to remedy the antecedent basis issue. Accordingly, Applicant submits that new claim 47 is in condition for allowance.

3. Anticipation Rejections

i. Rejection based on Hoffschneider

Pages 3-4 of the Office Action reject claims 32, 34, and 36 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,885,035 to Hoffschneider et al. ("*Hoffschneider*"). Applicant respectfully traverses this rejection. Of the rejected claims, claim 32 is the sole

independent claim. Applicant submits that *Hoffschneider* does not anticipate claims 32, 34, and 36 because *Hoffschneider* does not include each and every claim limitation recited in the rejected claims.

Hoffschneider discloses a filing tool 10 for filing trowel edges. See Abstract. As shown in Figures 1 and 2 of *Hoffschneider*, filing tool 10 has a hollow body 12 having a top wall 28 and a bottom wall 32. A flat metal file 20 (which the Office Action equates to the “rasp body” recited in claim 32) is disposed within body 12 near top wall 28. Bottom wall 32 is split, with a narrow through slot 36 being formed therein. Turning to Figure 4 of *Hoffschneider*, a conventional trowel T is also disclosed having a planar blade B (which the Office Action equates to the “rasp guide” recited in claim 32) with a handle portion (which the Office Action equates to the “elongated retention rod” recited in claim 32) affixed thereto and extending therefrom. The handle portion in *Hoffschneider* appears to be permanently attached to blade B and *Hoffschneider* does not teach otherwise.

As shown in Figure 5 of *Hoffschneider*, during use blade B of trowel T is inserted through slot 36 until the long edge L of blade B contacts file 20. Trowel T is then moved back and forth (see arrows 50) within slot 36 relative to filing tool 10. This causes the worn edges to be filed down by the raspy surface of file 20. This is the only rasp or other type of cutting edge surface disclosed in *Hoffschneider*. Applicant notes that filing tool 10 and trowel T are separate devices that are not attached or connected together.

Hoffschneider discloses that the guide slot 36 is only wide enough to “allow close-fitting removable insertion of the trowel’s long edge L.” See col. 5, lines 48-50. If the *Hoffschneider* file 20 (which, as noted above, is equated to the “rasp body” of claim 32 by the Office Action) was placed on a tibial facet, the raspy surface of file 20 would be prevented from contacting the

facet by the body 12, which encloses file 20. Applicant submits that slot 36 would not be wide enough to allow the raspy surface of file 20 to contact the facet. In view of the foregoing, Applicant respectfully submits that *Hoffschneider* does not disclose or suggest “a rasp body having a bottom surface with a plurality of cutting edges, **the rasp body being adapted for placement on a lateral or medial facet at a proximal end of a tibia such that the plurality of cutting edges can contact the facet.**” as recited in amended claim 32. Applicant notes that “adapted for” limitation in claim 32 is a distinct structural limitation of the claim and as such should be given weight accordingly. This is proper according to the MPEP, which lists various phrases, including “adapted for,” then states that “[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case.” MPEP § 2111.04.

Furthermore, because filing tool 10 (including file 20) and trowel T (including blade B, which, as noted above, is equated to the “rasp guide” of claim 32 by the Office Action) are separate devices that are not attached or connected together, Applicant respectfully submits that *Hoffschneider* also does not disclose or suggest “a rasp guide **mounted** on the rasp body” as recited in claim 32.

Finally, because handle portion (which the Office Action equates to the “elongated retention rod” recited in claim 32) appears to be permanently attached to blade B, Applicant respectfully submits that *Hoffschneider* also does not disclose or suggest “an elongated retention rod having a connector adapted to **removably couple** with the rasp guide,” as recited in claim 32.

In view of the foregoing, Applicant respectfully submits that the anticipation rejection of claim 32 should be withdrawn. Claims 34, 36, and new claims 44-46 depend from claim 32 and thus incorporate the limitations thereof. As such, applicant submits that claims 34, 36, and 44-46

are distinguished over the cited art for at least the same reasons as discussed above with regard to claim 32. Accordingly, Applicant respectfully requests that the anticipation rejection of claims 32, 34 and 36 be withdrawn.

ii. Rejection based on Pennig

Pages 4-5 of the Office Action reject claims 37-40, 42, and 43 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,346,496 to Pennig ("*Pennig*"). Applicant respectfully traverses the rejection. Of the rejected claims, claim 37 is the sole independent claim. Applicant submits that *Pennig* does not anticipate claims 37-40, 42, and 43 because *Pennig* does not include each and every claim limitation recited in the rejected claims.

Pennig discloses a drill-guide device for aligning bone screws driven into the neck of a femur. The drill guide device can be attached to an intermedullary nail 1 that has previously been inserted lengthwise into the shaft of the femur. See Abstract. As shown in Figures 1 and 2, the drill-guide device includes a suspension bar 6 that can be rotatably connected to the top of intermedullary nail 1 (the Office Action equates this combination of intermedullary nail 1 and suspension bar 6 to the "retention rod" recited in claim 37). See Col. 2, lines 47-54. The drill guide device also includes a drill template or jig 5 attached to suspension bar 6. Template 5 is generally box shaped, having a front face and an opposing back face that are generally parallel to intermedullary nail 1, with a top face orthogonal to and extending between the front and back faces. A suspension arm 11 extends upward from the top face of template 5 to connect to suspension bar 6. A plurality of drill-guide bores 3, 4 extend completely through template 5 from the front face to the back face. Drill-guide bores 3, 4 are configured so as to permit bone screw alignments into the femoral head on opposite sides of and generally transverse to the longitudinal axis of intermedullary nail 1. See col. 1, lines 40-57. Applicant notes that the face

of template 5 that is connected to suspension bar 6 (the top face) is different than the faces through which drill-guide bores 3, 4, extend (the front face and the back face).

As such, even if, *arguendo*, the front and back faces of template 5 of *Pennig* are equated to the claimed “top surface” and “bottom surface” and the suspension bar 6 of *Pennig* is equated to the claimed “retention rod” as recited in claim 37, because suspension bar 6 does not attach to the front or back face of template 5, Applicant respectfully submits that *Pennig* does not disclose or suggest “a first resecting template comprising a top surface and an opposing bottom surface, the first resecting template at least partially bounding a first guide space extending through the first resecting template from the top surface to the bottom surface... and means for removably attaching the retention rod to the top or bottom surface of the first resecting template,” as recited in amended claim 37.

In view of the foregoing, Applicant respectfully submits that the anticipation rejection of claim 37 should be withdrawn. Claims 38-40, 42, and 43 depend from claim 37 and thus incorporate the limitations thereof. As such, applicant submits that claims 38-40, 42, and 43 are distinguished over the cited art for at least the same reasons as discussed above with regard to claim 37. Accordingly, Applicant respectfully requests that the anticipation rejection of claims 37-40, 42, and 43 be withdrawn.

Furthermore, Applicant submits that it would not be obvious to modify *Pennig* to suggest the aforementioned limitation of claim 37. *Pennig* discloses that the connection point between suspension bar 6 and template 5 is on the top surface of template 5 so as to allow vertical adjustability that is parallel to the axis of the intermedullary nail. See col. 3, lines 6-11. Moving the connecting point to the front or back surface would cause more complexity and would likely interfere with the drill-guide bores 3, 4.

4. Obviousness Rejection

Page 5 of the Office Action rejects claim 41 under 35 USC § 103(a) as being unpatentable over *Pennig*. Claim 41 depends from claim 37 and thus incorporates the limitations thereof. As such, applicant submits that claim 41 is distinguished over the cited art for at least the same reasons as discussed above with regard to claim 37. Accordingly, Applicant respectfully requests that the obviousness rejection of claim 41 be withdrawn.

5. Double Patenting Rejection

Pages 6 and 7 of the Office Action provisionally reject claims 32, 33, and 37 under the judicially created doctrine of obviousness-type double patenting in view of claims 76 and 81 of copending U.S. Patent Application No. 10/798,665. Applicant acknowledges the provisional obviousness-type double patenting rejection and will address any formal obviousness-type double patenting rejection once either the present application or the '665 application has issued.

6. Allowable Subject Matter

Page 7 of the Office Action objects to claim 35 as being dependent upon a rejected base claim, but states that claim 35 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, as noted above, Applicant has herein rewritten claim 35 in independent form as new claim 50, incorporating the limitations of claim 32, from which claim 35 previously depended.

In connection with the foregoing, Applicant respectfully notes that an objection, by definition, concerns only the form of the claim(s) (as distinguished from the substance of the claim) with respect to which the objection has been posed. *See* MPEP §§ 706.01, 608.01(n)

(emphasis added). Thus, simply rewriting a dependent claim in the manner suggested by the Examiner constitutes only a change to the format of the claim and, without more, has no effect with regard to the substance of the rewritten claim.

Accordingly, because new claim 50 is simply claim 35 rewritten in independent form to include all of the limitations of the previously pending base claim and any intervening claims, Applicant respectfully submits that no change has been made herein to the substance the claim.

No other objections or rejections are set forth in the Office Action.

D. New Claims 48 and 49

Applicant submits that each of new claims 48 and 49 is distinguished over the cited art of record. For example, claim 48 recites, among other things “a rasp body having a bottom surface with a plurality of cutting edges formed thereon, ... **an opening being formed on the bottom surface; a rasp guide having at least a portion thereof secured within the opening formed on the bottom surface of the rasp body.** ... and an elongated retention rod **removably coupled** with the rasp guide.” Claim 49 depends from claim 48, thus incorporating the limitations thereof, and further recites “**a portion of the rasp guide projects from the opening and past the bottom surface of the rasp body.**” Applicant respectfully submits that neither *Hoffschneider* nor *Pennig* teach or suggest the aforementioned limitations in conjunction with the other limitations of claims 48 and 49. As such, Applicant respectfully submits that claims 48 and 49 are distinguished over the cited art.

E. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 32, 33, and 35-50 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 29th day of August 2007.

Respectfully submitted,

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